

**REMARKS**

Claims 1 and 23 are pending in the present application. Claims 2-22 and 24-46 have been cancelled without prejudice or disclaimer to the subject matter contained therein.

**Rejection under 35 U.S.C. §103 over Czerwinski et al. in view of Mander et al.**

Claims 1 and 23 have been rejected under 35 U.S.C. §103 as being unpatentable over Czerwinski et al. (Published US Patent Application 2004/0066414) in view of Mander et al. (US-A-6,243,742). This rejection under 35 U.S.C. §103 is respectfully traversed.

In formulating the rejection under 35 U.S.C. §102(e), the Examiner alleges that Czerwinski et al. discloses a method that selects a first icon associated with a first opened document being displayed on the electronic desktop of the electronic device; places the first icon associated with the first opened document onto a second icon associated with a second opened document; and modifies an appearance of the first icon associated with the first opened document to represent a portion of a virtual pile of opened documents when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. The Examiner further alleges that Czerwinski et al. discloses a method that maintains an appearance of the second icon when the first icon is placed onto the second icon; selects a third icon associated with a third opened document being displayed on the electronic desktop of the electronic device; places the third icon associated with the first opened document onto the second icon associated with the second opened document; modifies an appearance of the third icon associated with the third opened document to represent a portion of the virtual pile of opened documents when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document; and maintains the appearance of the second icon when the third icon is placed onto the second icon.

However, the Examiner recognizes that Czerwinski et al. fails to disclose modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

Moreover, the Examiner recognizes that Czerwinski et al. fails to disclose modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document.

To meet this deficiency in Czerwinski et al., the Examiner proposes to modify the teachings of Czerwinski et al. with the teachings of Mander et al. The Examiner alleges that “within the scope and spirit of the disclosed invention,” Mander et al. teaches modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Furthermore, the Examiner alleges that “within the scope and spirit of the disclosed invention,” Mander et al. teaches modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the second icon associated with the second opened document.

From these allegations, the Examiner concludes that the combined teachings of Czerwinski et al. and Mander et al. render the presently claimed invention obvious to one of ordinary skill in the art. These allegations and conclusion are respectfully traversed.

As set forth above, independent claim 1 recites a method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device, an opened document being an application invoked created area on the electronic desktop of the electronic device by displaying a first icon associated with a first opened document in a predetermined form; displaying a second icon associated with a second opened document in the predetermined form; displaying a third icon associated with a third opened document in the predetermined form; and selecting the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device; placing the first icon associated with the first opened document onto the second icon associated with the second opened document.

The method modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the

second opened document; displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder; selects the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device; places the third icon associated with the third opened document onto the virtual pile icon; modifies an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon; and modifies the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document and the second single line segment representing the third icon associated with the third opened document thereunder.

As noted in Applicant's previous Response, Czerwinski et al. teaches, at paragraph [0037], and illustrates in Figures 2A and 2B, a method that creates a group icon **126** when two icons (**118, 120**), having an appearance of an oval, are joined together. As clearly illustrated in Figures 2A and 2B, the group icon **126** provides a border around the two icons (**118, 120**) to illustrate the relationship; however, Czerwinski et al. teaches and illustrates that the oval appearance of the two icons (**118, 120**) within the group icon **126** are maintained. Moreover, in Figure 7, Czerwinski et al. teaches and illustrates that the oval appearance of the icons (**118, 120, and 140**) within the group icon **140** are maintained. Thus, Czerwinski et al. teaches the creation of a group icon, but that the individual icons, which created the group, are **not** modified in appearance, but remain unchanged.

In contrast, as noted in Applicant's previous Response, independent claim 1 recites a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document. Moreover, independent claim 1 recites displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form

with the first single line segment representing the first icon associated with the first opened document thereunder.

In other words, the virtual pile icon of independent claim 1 includes the second icon in the predetermined form (unchanged) and the first single line segment representing the first icon (changed) associated with the first opened document.

This allows the majority of the virtual pile icon's visual identification to remain unchanged. By keeping the majority of the virtual pile icon's visual identification unchanged, a user can easily recognize the virtual pile and remember the contents thereunder. Moreover, the maintaining of the majority of the virtual pile icon's visual identification allows the use to insert documents into the pile using a single step without disrupting the visual identification of the virtual pile.

To address this deficiency in Czerwinski et al., the Examiner asserts that "within the scope and spirit of the disclosed invention," Mander et al. suggests modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

It is readily apparent from the Examiner's argument that the Examiner recognizes that Mander et al. fails to disclose modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon. Notwithstanding, the Examiner asserts that somewhere in the "scope and spirit" of Mander et al., one of ordinary skill in the art would find a suggestion to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

Initially, what are the boundaries of the "scope and spirit" of the disclosed invention of Mander et al.? Does the Examiner mean that the claims (the conventional vehicle for defining the "scope" of a disclosed invention) teach modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon? What is the test for discerning the "spirit" of the disclosed invention?

It is respectfully submitted that the Examiner's reliance upon an alleged suggestion "within the scope and spirit of the disclosed invention" is outside the scope of a proper analysis of obviousness under 35 U.S.C. §103.

However, assuming, en arguendo, that the Examiner can hypothesize about “the scope and spirit of the disclosed invention” to create a suggestion, the suggestion created by the Examiner is contrary to the plain teachings of Mander et al..

As recognized by the Examiner, the plain teachings of Mander et al. disclose that the virtual pile’s appearance is modified to reflect the icon of a first document when the first icon is placed onto the virtual pile. Notwithstanding this explicit teaching, the Examiner asserts that since Mander et al. teaches the ability to place the icon associated with the first document within the virtual pile, and when the icon associated with the first document is placed within the virtual pile, the icon associated with the first document is changed.

Although Mander et al. teaches the ability to place the icon associated with the first document within the virtual pile, this placement requires more than dropping the icon of the document onto the icon of the virtual pile. Mander et al. teaches that to place the icon associated with the first document within the virtual pile, the icon of the document is held over the virtual pile until the pile is partially de-stacked to show the user locations to place the icon. If the user desires a different location within the stack, Mander et al. teaches that a movement of the cursor will create another location(s) for placing the icon. Once the location is selected, Mander et al. teaches that the user releases the icon to the pile.

Mander et al. teaches this de-stacking of the pile for icon placement so that the virtual pile is a true replica of a physical pile of documents. When placing a physical document on top of a document pile, the document is physically on the top of the pile. In other words, Mander et al. teaches that when an icon representing a document is placed upon the top of an icon of a virtual pile, the icon representing the document is visually represented on top of the pile. Thus, the “scope and spirit” of Mander et al. is to create a virtual system which is a faithful replica of the corresponding physical system.

On the other hand, the claimed invention does not faithfully replicate a physical pile.

Therefore, contrary to the Examiner’s allegation, the “scope and spirit” of Mander et al., fails to suggest to one of ordinary skill in the art to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

In summary, since Czerwinski et al. and Mander et al. each singly fails to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document, the combined teachings of Czerwinski et al. and Mander et al. fail to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

With respect to dependent claim 23, the Applicant, for the sake of brevity, will not address the reasons supporting patentability for this individual dependent claim, as this claim depends directly from allowable independent claim 1. The Applicant reserves the right to address the patentability of this dependent claim at a later time, should it be necessary.

Accordingly, in view of the remarks set forth above, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 U.S.C. §103.

### **CONCLUSION**

Accordingly, in view of all the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the present rejection. Also, an early indication of allowability is earnestly solicited.

Respectfully submitted,



Michael J. Nickerson  
Registration No. 33,265  
Basch & Nickerson LLP  
1777 Penfield Road  
Penfield, New York 14526  
Telephone: (585) 899-3970 Ext. 105  
Customer No. 37211

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